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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,250	11/27/2001	Yuri Adrian Tijerino	01-40236-US-C	1988

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Louis M. Heidelberg
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2500 One Liberty Place
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EXAMINER

TRINH, SONNY

ART UNIT	PAPER NUMBER
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2687

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/995,250		TIJERINO, YURI ADRIAN	
	Examiner		Art Unit	
	Sonny TRINH		2687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7-10, 13, 16, 23-26, 32, 37, 40, 47-51, 55, 61-63, 67, 69-71 and 74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2-6, 11-12, 14-15, 17-22, 27-31, 33-36, 38-39, 41-46, 52-54, 56-60, 64-66, 68, 72-73, 75-76 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/27/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group VI (claims 7, 23, 32, 47, 61 and 67) in the reply filed on 11/04/2004 is acknowledged. The traversal is on the ground(s) that "...examination of the entire application can be made without a serious burden and, therefore, the examiner should examine it on the merits even if it claims independent and distinct inventions...". This is not found persuasive because the claims contain different distinct species and were grouped into 7 distinct groups which were presented to Applicant in the restriction requirement.

In response to Applicant that none of the Groups, as defined by Examiner, contain an independent claim, Examiner respectfully submits that due to the restriction of species, all generic claims are automatically elected, therefore claims 1, 7, 16, 23, 26, 32, 40, 47, 55, 61, 67 will be examined together with the claims of the elected group VI. Claims 1, 7-10, 13, 16, 23-25, 26, 32, 37, 40, 47-51, 55, 61-63, 67, 69-71, and 74 are still pending.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claim 1** is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,405,034. Although the conflicting claims are not identical, they are not patentably distinct from each other because patent granted to Tijerino, (6,405,034 B1) with common assignee, discloses the claimed invention of claim 1.

Limitations of claim 1 recite:

A system for providing a mobile communication device with information, said system comprising:

1) at least one server being communicable with said mobile communication device to communicate service choices and said information to said mobile communication device; wherein,

2) upon selection of at least one of said service choices, said mobile communication device augments said selection with data at least partially indicative of preference data; and

3) wherein the at least one server utilizes said augmented selection to identify information corresponding to said augmented selection and communicate the identified information to the mobile communications device.

Limitations 1-3 are taught by claim 2, of Patent 6,405,034.

3. **Claims 7-8** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,405,034. Although the conflicting claims are not identical, they are not patentably distinct from each other because patent granted to Tijerino, (6,405,034 B1) with common assignee, discloses the claimed invention of claim 7.

Limitations of claim 7 recite:

A system for providing a mobile communication device with information, said system comprising:

1) at least one server being communicable with said mobile communication device to communicate service choices and said information to said mobile communication device; wherein,

2) upon selection of at least one of said service choices, said mobile communication device augments said selection with data at least partially indicative of environmental data; and

3) wherein the at least one server utilizes said augmented selection to identify information corresponding to said augmented selection and communicate the identified information to the mobile communications device.

Limitations 1-3 are taught by claim 1, of Patent 6,405,034.

Limitations of claim 8 recite:

1) wherein the environmental data includes data selected from one or more of the group consisting of a current position of the mobile communication device, a current time, a current temperature, a current weather condition, and user scheduling information.

Limitation 1 is taught by claim 1, of Patent 6,405,034.

4. **Claims 9-10, 13** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,405,034 in view of Alpevorich et al. ("Alpevorich"; U.S. Patent Number 6,233,448 B1).

Regarding claims 9-10, 13, claim 1 of U.S. Patent No. 6,405,034 discloses everything as specified in claim 8 but does not explicitly disclose that the current position of the mobile communications device is determined internally to the mobile communications device nor the current position of the mobile communications device is acquired via an interface to an external position data source.

In an analogous art, Alpevorich discloses the system, method and apparatus for automatic feature activation/deactivation based upon the position of a mobile station.

Alpevorich further teaches that the location of the mobile station can be calculated using the device internally to the mobile device such as GPS or the location can be calculated using the well known technique such as triangulation (external to the mobile) (see column 3 lines 29-52).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to incorporate the GPS circuitry, or the triangulation technique, as taught by Alpevorich, to claim 1 of Patent Number 6,405,034 in order to determine the position of the mobile station with a high degree of accuracy (GPS is known for the excellent location determination), also the motivation for using the triangulation technique is to employ the existing base stations to calculate the position of the mobile station without having to add additional circuitry to the mobile device itself.

5. **Claims 16, 23** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,405,034. Although the conflicting claims are not identical, they are not patentably distinct from each other because patent granted to Tijerino, (6,405,034 B1) with common assignee, discloses the claimed invention of claim 16 and 23 including the preference data and environment data with variation in wordings only.

6. **Claims 24-25** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,405,034. Although the conflicting claims are not identical, they are not patentably

distinct from each other because patent granted to Tijerino, (6,405,034 B1) with common assignee, discloses the claimed invention of claim 24 including the environmental data wherein data are selected from one or more of the group consisting of a current position of the mobile communication device, a current time, a current temperature, a current weather condition, and user scheduling information.

7. **Claims 26, 40** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,405,034. Although the conflicting claims are not identical, they are not patentably distinct from each other because patent granted to Tijerino, (6,405,034 B1) with common assignee, discloses the claimed invention of claim 26 including the mobile communication device with a user interface being suitable to select one or more service choices provided by a server; and a positioning device being suitable to provide position data; wherein, when said mobile device receives service choices from said server, and at least one of said service choices is selected using said user interface, said mobile communication device augments said selection with preference indicative data and transmits said augmented selection to said server.

Regarding **claim 40**, this claim merely reflect the method claim as opposed to the apparatus claim of claim 26 and is therefore rejected for the same reasons.

8. **Claims 32, 37, 61-63** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4, and 6

(combined) of U.S. Patent No. 6,405,034. Although the conflicting claims are not identical, they are not patentably distinct from each other because patent granted to Tijerino, (6,405,034 B1) with common assignee, discloses the claimed invention of claims 32 and 37 including the mobile communication device with a user interface being suitable to select one or more service choices provided by a server; and a positioning device being suitable to provide position data; wherein, when said mobile device receives service choices from said server, and at least one of said service choices is selected using said user interface, said mobile communication device augments said selection with environmental indicative data and transmits said augmented selection to said server and wherein said the mobile communication device includes one or more of components selected from the group consisting of a positioning device, a thermometer, a barometer, and a clock.

Regarding **claims 47-49**, these claims merely reflect the method claim as opposed to the apparatus claim of claims 32 and 37 and are therefore rejected for the same reasons.

Regarding **claims 61-63**, these claims merely reflect the method claim as opposed to the system claim of claims 2, 4, 6 and are therefore rejected for the same reasons.

9. **Claims 50-51** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4, 6 of U.S. Patent No. 6,405,034 in view of Alpevorich et al. ("Alpevorich"; U.S. Patent Number 6,233,448 B1).

Regarding **claims 50-51**, claims 2, 4, 6 of U.S. Patent No. 6,405,034 discloses everything as specified in claim 49 but does not explicitly disclose that the current position of the mobile communications device is determined internally to the mobile communications device nor the current position of the mobile communications device is acquired via an interface to an external position data source.

In an analogous art, Alpevorich discloses the system, method and apparatus for automatic feature activation/deactivation based upon the position of a mobile station. Alpevorich further teaches that the location of the mobile station can be calculated using the device internally to the mobile device such as GPS or the location can be calculated using the well known technique such as triangulation (external to the mobile) (see column 3 lines 29-52).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to incorporate the GPS circuitry, or the triangulation technique, as taught by Alpevorich, to claim 1 of Patent Number 6,405,034 in order to determine the position of the mobile station with a high degree of accuracy (GPS is known for the excellent location determination), also the motivation for using the triangulation technique is to employ the existing base stations to calculate the position of the mobile station without having to add additional circuitry to the mobile device itself.

10. **Claim 55** is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24 of U.S. Patent No. 6,405,034. Although the conflicting claims are not identical, they are not patentably distinct from

each other because patent granted to Tijerino, (6,405,034 B1) with common assignee, discloses the claimed invention of claim 55 including the method of providing identified information to at least one mobile communications device from at least one server, said method comprising: transmitting service choices from said at least one server to said mobile communication device; selecting one or more service choices with said mobile communication device; supplementing said selection with augmented data comprising preference data; transmitting said augmented selection from said mobile communication device to said at least one server; utilizing a facilitator to identify information corresponding to said augmented selection; and communicating the identified information to the mobile communications device.

11. **Claims 67, 69 and 74** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24 and 26 (combined) of U.S. Patent No. 6,405,034. Although the conflicting claims are not identical, they are not patentably distinct from each other because patent granted to Tijerino, (6,405,034 B1) with common assignee, discloses the claimed invention of claims 67, 69 and 74 including a method of obtaining information from at least one server using a mobile communications device, said method comprising: receiving service choices by a mobile communication device from at least one server; selecting one or more said service choices as selection choices with a mobile communications device, augmenting said selection choices within said mobile communications device with preference data and position data; transmitting said augmented selection choices

to said at least one server and receiving information identified by said at least one server corresponding to said augmented selection choices.

12. **Claims 70-71** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24, 26 of U.S. Patent No. 6,405,034 in view of Alpevorich et al. ("Alpevorich"; U.S. Patent Number 6,233,448 B1).

Regarding **claims 70-71**, claims 24, 26 of U.S. Patent No. 6,405,034 discloses everything as specified in claim 69 but does not explicitly disclose that the current position of the mobile communications device is determined internally to the mobile communications device nor the current position of the mobile communications device is acquired via an interface to an external position data source.

In an analogous art, Alpevorich discloses the system, method and apparatus for automatic feature activation/deactivation based upon the position of a mobile station. Alpevorich further teaches that the location of the mobile station can be calculated using the device internally to the mobile device such as GPS or the location can be calculated using the well known technique such as triangulation (external to the mobile) (see column 3 lines 29-52).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to incorporate the GPS circuitry, or the triangulation technique, as taught by Alpevorich, to claim 1 of Patent Number 6,405,034 in order to determine the position of the mobile station with a high degree of accuracy (GPS is known for the excellent location determination), also the motivation for using the

triangulation technique is to employ the existing base stations to calculate the position of the mobile station without having to add additional circuitry to the mobile device itself.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny TRINH whose telephone number is 571-272-7927. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester KINCAID can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SONNY TRINH
PRIMARY EXAMINER

4/5/05